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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/868,694 | 10/10/2001 | Benoit Patrick Bertrand | 05222.00153 | 3243 |

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EXAMINER

HIRL, JOSEPH P

ART UNIT PAPER NUMBER

2121

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/868,694 | Applicant(s) BERTRAND ET AL. | |
| | Examiner Joseph P. Hirl | Art Unit 2121 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>020205</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to an AMENDMENT entered November 16, 2004 for the patent application 09/868,694 filed on October 10, 2001.
2. The First Office Action of August 16, 2004 is fully incorporated into this Final Office Action by reference.

Status of Claims

3. Claims 1-18 are amended. Claims 1-18 are pending.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

5. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

6. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 10/11 of U.S. Patent No. 6,016,486. Although the conflicting claims are not identical, they are not patentably distinct from each other because providing a dynamic toolbar (logic/code) on the display to assist the student with achieving the goal anticipates managing information flow (logic/code) (species anticipates the genus).

8. Claims 1 and 10 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 10 of copending Application No. 10/852,551. Although the conflicting claims are not identical, they are not patentably distinct from each other because providing a dynamic toolbar (logic) on the display to assist the student with achieving the goal anticipates reporting the progress toward the goal (logic) (species anticipates the genus).

9. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Cook et al (WO 97/44766 referred to as **Cook**).

Claims 1, 10

Cook anticipates (a) receiving indicia representative of a goal and presenting the goal on a display (**Cook**, p 10, I 24-31; Fig.4); (b) integrating examples into the presentation to provide assistance with achieving the goal (**Cook**, p 10, I 24-31; Fig.4; p 8, I 8-13); (c) monitoring progress of a student toward the goal and providing feedback that further assists the student in accomplishing the goal (**Cook**, p 10, I 24-31; Fig.4; p 8, I 8-13); and (d) providing a dynamic toolbar on the display to assist the student with achieving the goal (**Cook**, Fig. 3, item 310) (EN: processor, memory and control logic are genetic features of a computer to be found through out the prior art of Cook).

Claims 2, 11

Cook anticipates the dynamic toolbar is instantiated from information in a database (**Cook**, p 32, l 17-18 ;p 10, l 33-37; Examiner's Note (EN): to one of ordinary skill in the art, the logic of the toolbar and other features are resident in a data base; such is the generic way a computer operates).

Claim 3

Cook anticipates credit-processing material is integrated into the presentation. (**Cook**, p 12, l 3-34; p 20, l 10-14; EN: claim 1 is silent on creating an accounting goal; credit processing in concept is present in all professional disciplines (i.e. business, teaching, engineering, science, etc.).

Claims 4, 13

Cook anticipates the dynamic toolbar contains utilities that are integrated into the presentation (**Cook**, p 6, l 25-37; p 32, l 17-23; EN: utilities represent generic software (logic) necessary to provide functionality).

Claims 5, 14

Cook anticipates wherein the dynamic toolbar is instantiated by a message from the presentation to a database object containing information indicative of the current status of a presentation (**Cook**, p 9, l 12-24; p 10, l 33-37; p 11, l 1-9; p 24, l 12-23; p 32, l 17-23).

Claims 6, 15

Cook anticipates the dynamic toolbar contains polymorphic logic that is dynamically instantiated based on characteristics of the presentation when the toolbar is

instantiated (**Cook**, p 7, l 10-29; p 21, l 9-23; p 32, l 17-23; EN: polymorphic logic is whatever logic).

Claims 7, 16

Cook anticipates wherein the dynamic toolbar includes linkages to an Internet (**Cook**, p 7, l 11-18; p 10, l 17-24; p 32, l 17-23).

Claims 8, 17

Cook anticipates the dynamic toolbar includes an interface to perform electronic mail management (**Cook**, p 10, l 17-24; p 32, l 17-23).

Claims 9, 18

Cook anticipates the dynamic toolbar includes an interface that supports telephony functions from the presentation (**Cook**, p 10, l 17-24; p 11, l 17-22; p 28, l 27-37; p 29, l 1-2; p 32, l 17-23).

Claim 12

Cook anticipates the dynamic toolbar is context-sensitive to the presentation (**Cook**, p 9, l 12-24; p 10, l 33-37; p 11, l 1-9; p 24, l 12-23; p 32, l 17-23; EN: context being substance).

Response to Arguments

12. The proposed amended title is acceptable.
13. The Typographical Errors correction are acceptable.

14. The objection to the Oath/Declaration is withdrawn.
15. Based on the response to the "request for Information", the applicant has inferred that Smialek does not have a position against the instant application and that the Response of February 7, 2002 is complete. Therefore, the Examiner withdraws the "Request for Information."
16. The objection to the Information disclosure Statement is withdrawn.
17. The drawing objection is withdrawn.
18. The specification objection is withdrawn.
19. The abstract objection is withdrawn.
20. Applicant's arguments related to Double Patenting have been fully considered but are not persuasive.

In reference to Applicant's argument:

The Applicant respectfully submits that claims 1 and 10 are patentable over claims 1, 10, and 11 of US 6,016,486. For example, claim 1 of the present application includes the features of "monitoring progress of a student toward the goal and providing feedback that further assists the student in accomplishing the goal" and "providing a dynamic toolbar on the display to assist the student with achieving the goal" while claim 1 of US 6,016,486 includes the features of "managing information flow utilizing a linked list" and "evaluating progress toward the goal and providing feedback that further motivates accomplishment of the goal." The Applicant submits that the differences of these features patentably distinguish claim 1 of the present application from claim 1 of US 6,016,486. The Office Action alleges that "providing a dynamic toolbar (logic/code) on the display to assist the student with achieving the goal anticipates managing information flow (logic/code) (species anticipates genus)." However, the feature of "providing a dynamic toolbar on the display to assist the student with achieving the goal" does not provide; information flow and thus does not anticipate the feature of "managing information flow utilizing a linked list." Moreover, the feature of "providing a dynamic toolbar on the display to assist the student with achieving the goal" does not even suggest "utilizing a linked list." For at least the above reasons, claim 1 is patentable over claims 1, 10, and 11 of US 6,016,486. Similarly, claim 10 of the present application includes "logic that monitors progress of a student toward the goal and provides feedback that further provides the student assistance in accomplishing the goal" and "logic that presents a dynamic toolbar on the display to assist the student with achieving the goal."

Examiner's response:

Para 27. applies. The dynamic tool bar on the display directly provides an information link to the student or user of the display (information flow, movement, transmission, etc.). The linked list provides the dynamic toolbar means for interfacing between the user and the machine. Further, the species anticipates the genus.

In reference to Applicant's argument:

Claims 1 and 10 are provisionally rejected by the Office Action under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 10 of co-pending Application No. 10/852,551. The Applicant respectfully submits that claims 1 and 10 are patentable over claims 1 and 10 of Application No. 10/852,551. For example, claim 1 of the present application includes the features of "monitoring progress of a student toward the goal and providing feedback that further assists the student in accomplishing the goal" and "providing a dynamic toolbar on the display to assist the student with achieving the goal" while claim 1 of Application No. 10/852,551 includes the features of "querying a user to determine characteristics of the user", "evaluating progress toward the goal and providing feedback that further motivates accomplishment of the goal", and "reporting the progress toward the goal." The Applicant submits that the differences of these features patentably distinguish claim 1 of the present application from claim 1 of Application No. 10/852,551. The Office Action alleges that "providing a dynamic toolbar (logic) on the display to assist the student with achieving the goal anticipates reporting the progress toward the goal (logic) (species anticipates genus)." However, the feature of "providing a dynamic toolbar on the display to assist the student with achieving the goal" does not report progress and thus does not anticipate the feature of "reporting the progress toward the goal." Moreover, claim 1 of Application No. 10/852,551 includes the feature of "querying a user to determine characteristics of the user" which is not included in claim 1 of the present application. For at least the above reasons, claim 1 is patentable over claims 1 and 10, and 11 of Application No. 10/852,551. Similarly, claim 10 of the present application includes "logic that monitors progress of a student toward the goal and provides feedback that further provides the student assistance in accomplishing the goal" and "logic that presents a dynamic toolbar on the display to assist the student with achieving the goal."

Examiner's response:

Para 27 applies. The dynamic toolbar is function (logic) oriented and with each action of the toolbar, something happens...prior to the student's action with the toolbar, the student had a goal in mind...hence the dynamic toolbar's action contributes to the student's goal and there will be associated with any action of the dynamic toolbar by the student, an immediate feedback to the student that will report progress toward the goal. Simply, such is the interface actions of a student and a dynamic toolbar. The querying

of the user is simply offering the student various functions on the toolbar...which function do you (the student) wish to use? The student's answer ...toolbar activity...establishes characteristics of the student...the student's answer. The logic of claim 10 is simply the means for associated with the tool bar. Again the species anticipates the genus.

21. The rejections of claims 1 and 10 under 35 USC 102 (f) and (g) are withdrawn.
22. The rejections of claims 6, 9, 15 and 18 under 35 USC 112, second paragraph, are withdrawn.
23. The rejections of claims 1-9 under 35 USC 101 are withdrawn.
24. Applicant's arguments filed on November 16, 2004 related to Claims 1-18 have been fully considered but are not persuasive.

In reference to Applicant's argument:

Regarding claim 1, Cook does not teach or even suggest the feature of "providing a dynamic toolbar on the display to assist the student with achieving the goal." Referring to Figure 3, Cook does disclose (Page 54, lines 11-14):

Below file system toolbar 306 is toolbar 310 for tools the system has access to. Illustrated here are icons for a calculator, a word processor, communications, and starfish, a general purpose language tool.

It appears that Cook merely teaches a statically-configured toolbar for tools that are accessible by a student, where the toolbar does not change, for example, with a student's activity. Similarly, claim 10 includes "logic that presents a dynamic toolbar on the display to assist the student with achieving the goal."

Examiner's response:

Para 27 applies. Applicant admits that Cook @ Fig. 3 identifies a toolbar 310 that controls various functions. Controlling various functions is representative of a

dynamic toolbar. Further, Cook @ p 55, l 9-12 identifies another toolbar that is also dynamic in that the agent can facilitate help and hint request. Applicant should appreciate that any toolbar is dynamic since such toolbar will activate with the student's action. The logic requirements of claim 10 again are the means for the related function.

Examination Considerations

25. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, l 45-48; p 2100-9, c 1, l 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

26. Examiner's Notes are provided to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and

unless otherwise stated, the Examiner's Notes are not prior art but a link to prior art that one of ordinary skill in the art would find inherently appropriate.

27. Examiner's Opinion: Paras 25. and 26. apply. The Examiner has full latitude to interpret each claim in the broadest reasonable sense.

Conclusion

32. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

33. Claims 1-18 are rejected.

Correspondence Information

34. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is (571) 272-3685. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anthony Knight can be reached at (571) 272-3687.

Any response to this office action should be mailed to:

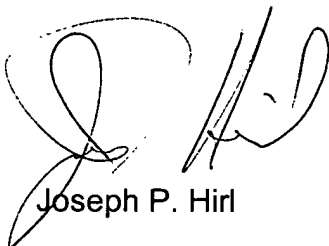
Commissioner of Patents and Trademarks,
Washington, D. C. 20231;

or faxed to:

(703) 872-9306 (for formal communications intended for entry);

or faxed to:

(571) 273-3685 (for informal or draft communications with notation of
"Proposed" or "Draft" for the desk of the Examiner).



Joseph P. Hirl

February 3, 2005